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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/849,991

05/20/2004

Rocco Burgo

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54380 7590 11/18/2009

FLASTER/GREENBERG P.C.

Four Penn Center

1600 John F. Kennedy Boulevard

2nd Floor

PHILADELPHIA, PA 19103

EXAMINER

CHANNAVAJALA, LAKSHMI SARADA

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/849,991	<b>Applicant(s)</b> BURGO, ROCCO	
	<b>Examiner</b> Lakshmi S. Channavajjala	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9-3-09.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Receipt of RCE dated 9-3-09 is acknowledged.

Claims 1-14 are pending in the instant application.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9-3-09 has been entered.

The RCE filed requests entering of amendment that have been previously un-entered on September 3, 2009. However, applicants have not filed any amendments on 9-3-09 (see the advisory action dated 2-24-09 and also applicants' response dated 2-3-09). Accordingly, the last set of claims presented on 5-20-04, for which a Final rejection has been issued (11-3-09) are considered for examination.

*The following rejections of record have been maintained:*

#### ***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-3, 5-11 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by either one of US 5,833,961 or US 5,989,527 to Siegfried et al (Siegfried).**

The disclosures of the above US patents to Siegfried are similar and therefore the disclosure of '961 is relied upon for the teachings. '961 disclose a polyester based sunscreen composition comprising polyol polyesters and sunscreen active agents. The exemplified compositions do not contain any silicone fluids and hence meet the negative limitation of claim 1. For the polyol polyesters, '961 teach that the polyester is a reaction product of at least one linear or branched aliphatic compound having two OH (diol) groups and at least one linear or branched chain aliphatic dicarboxylic acid and the diol may contain 2 to 10 ether linkages (col. 3, L 45-54). '961 further describes that the carboxylic acids contain 2 to 20 carbon atoms (col. 4, L 15-25) and the diols such as those recited in instant claim (col. 4, L30-45). For the preparation of the polyester, see lines bridging col. 4-5. Instant claim 8 does not recite any method and instead only recites a composition, which is taught by '961. For claims 5 and 13, '961 describe formula I, which meets the instant claimed formula. Therefore, the above patents of Siegfried anticipate instant claims.

***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of US 5,833,961 or US 5,989,527 to Siegfried et al (Siegfried).**

The disclosures of the above US patents to Siegfried are similar and therefore the disclosure of '961 is relied upon for the teachings. '961 disclose a polyester based sunscreen composition comprising polyol polyesters and sunscreen active agents. The teachings of the above patents are described above. Instant claims 4 and 12 recite specific carboxylic acids that form the polyester. While neither of the Siegfried patents mentioned above describe polyesters having only those claimed carboxylic acids, Siegfried states that their polyesters formed from a reaction of a diol and a diacid may further have the terminal end groups functionalized by reacting with a monofunctional acid having 2 to 40 carbon atoms such as propionic acid, butyric acid etc (col. 5, L 53 through col. 6, L20). Instant claims do not exclude polyol polyester that is a reaction product of diol and a diacid and also a monofunctional acid. Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to prepare polyol polyester containing both a monofunctional carboxylic acid as well as a diacid and still expect an effective sunscreen composition would have been within the scope of a skilled artisan because Siegfried teaches that the polyester compounds are effective in reducing the degree of penetration of the sunscreen composition through the outer stratum with the compounds having their end groups left as is or further functionalized.

***Response to Arguments***

3. Applicants did not present any arguments with the RCE filed on 9-3-09 and therefore the arguments presented (2-3-09 and 4-9-08) in response to the previous rejections are addressed here again:

4. Applicants' arguments filed on 2-3-09 have been considered but not found persuasive.

5. Applicants argue that none of the polyesters of Siegfried '961 read on the instant polyesters of formula I. The argument is not persuasive because '961 teaches that the polyester is a reaction product of at least one linear or branched chain aliphatic dihydric compound having two OH groups ie., at least one diol and at least one linear or branched aliphatic dicarboxylic acid (col. 3, L 45-55) and the carbon atoms in the acid and alcohol chains range from 2-20 carbon atoms, which includes the claimed 3-6 carbon atoms. Thus, in contrast to the argument, the compounds of '961 meet the compounds of formula I. '961 teach sunscreen formulation and hence meet instant personal care formulations. Applicants argue that '961 fail to identify the compounds as replacement for silicone fluids of low viscosity. However, instant claim 9 only recites the "replacement" in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. The argument that because '961 is silent with respect to silicone fluid it is not sufficient to meet the limitation i.e., "does not contain silicone fluid" is not persuasive

because instant claims recite that the composition should not contain silicone fluid and '961 compositions also lack the silicone fluids. Applicants have not shown how the lack of silicone fluid in the instant claims is different from the lack of silicone fluid of '961 reference. Applicants' arguments that a person of ordinary skill in the art would have no reason to modify the teachings of either of Siegfried's teachings to arrive at the claimed inventions 4 and 12 is not persuasive because the structural formula I in col. 5 suggests and reads on the in the instant formula I when the R2 of the patent is an aliphatic of C2-C10 carbon atoms.

6. Applicant's arguments filed 4-9-08 have been fully considered but they are not persuasive. Applicants' argue that "Siegfried '961 is directed to polyester based sunscreen formulations containing functionalized polyesters and at least two organic active sunscreen ingredients. None of the polyesters disclosed in Siegfried '961 has the specific structure of Formula I as claimed. With respect the argument, '961 teaches that the polyester is a reaction product of at least one diol, one diacid and a functionalized polyol or polyester. '961 further states that the polymer is a glycerin; diethylene glycol and adipate (see col. 2). The polyesters thus read on the instant claimed polyol polyesters and applicants have not shown how the polyol polyesters of '961 are different from the instant claimed. It is argued that Siegfried '961 has not identified the disclosed polyesters as having use as a replacement for low viscosity silicone fluids in personal care compositions, even though the examples of Siegfried '961 do not include a low viscosity silicone fluid, Siegfried '961 does not teach or suggest expressly that low viscosity silicone fluids should be omitted. It is argued that the invention as claimed is

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directed to compositions to replace the lower viscosity silicone fluid in conventional personal care composition or methods of preparing personal care products while retaining the skin feel and consistency attributes of personal care products that contain low viscosity silicone fluids. Moreover, a person of skill in the art would have had no apparent reason to modify either of the Siegfried to arise at the invention as claimed. Applicants' arguments are not persuasive because instant claims require that the composition be free of low viscosity silicone fluids, which is met by the teachings of '961. For the claimed replacement, even though '961 does not teach the limitation, '961 does not teach inclusion of such silicone and thus the teachings of '961 meet the structural limitations of instant claims and further would achieve the same benefits. With respect to optimization argued, argued by applicants, irrespective of whether the references recognizes the benefits.

### ***Conclusion***

7. This is a continuation of applicant's earlier Application No. 10/849991. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within



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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -5.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lakshmi S Channavajjala/  
Primary Examiner, Art Unit 1611  
November 8, 2009